



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,345	03/24/2004	Hidegori Toyose	Q80519	3494

23373 7590 06/08/2006
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

ADDISU, SARA

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/807,345

Applicant(s)

TOYOSE, HIDENORI

Examiner

Sara Addisu

Art Unit

3722

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4 and 6-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER

SA
6/2/06

Continuation of 3. NOTE: Regarding claim 1, Applicant argues (page 4, first and last paragraphs) that the Office Action does not give any motivation or suggestion the motivation to modify Hessman et al. with Ueno. Examiner respectfully points out that the motivation was given on page 6 of the office action mailed 12/15/05, last paragraph (i.e. for the purpose of preventing drawing-out of the screw). Furthermore, Applicant admits on page 5, lines 13-15 that "the use of crime prevention screw for preventing drawing-out of the screw makes sense in these application". Applicant also argues (page 5, last paragraph, last 3 lines and page 6) that "...simply adopting the resin-embedded crime prevention screw of Ueno in the cutter body of Hessman et al. would not allow the screw to be unsealed for readjustment and resealed as needed..". Examiner respectfully points out that as evidenced by Lemelson (4,318,874, Col. 1, lines 19-24), applying heat to resin-made material turns it into a molten state (in the case of the instant application, reading the claim broadly, this known method would unseal the wrench reception socket for adjustment). Furthermore, Applicant argues (page 6, first paragraph) that "...the present specification which exemplifies silicon rubber (not molding resin) as one such resin for use in the invention where adjustment and sealing can be repeated any number of times", Examiner points out that, it is noted that the features upon which applicant relies silicon rubber is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, Applicant's argument (page 6, second paragraph) that "Claim 6 requires that one or both of the wrench reception sockets has a shape that does not fit a wrench for use with the other, and it is this aspect of the invention that is not taught by "Official Notice" or any of the prior art cited by the Examiner". As explained in the Office Action mailed 12/15/05, Examiner asserts the fact that as long as the fastener being used meets the requirement for the application such as fatigue strength, pitch, size, grip length, torque requirements and other specification, selecting the type of wrench reception sockets the fastener has based on operators preference is old and well known. An example of a fastener/screw having a wrench reception socket that does not fit an Allen wrench, a Phillips screwdriver or a flat-tip screwdriver is TORX (as evidenced by Capuano, USP, 4,459,074, figures 1 and 3 and Col. 2, lines 1-10. Also look at Brugola, USP 5,577,871 , figure 3 and Col. 4, lines 7-11)..